

**Remarks**Rejections Under 35 USC §101

The Action rejects claim 15 under §101 for combining a method claim with a machine claim. The discussion of the rejection in the Action, however, appears to be directed to a claim that is not in this application and this rejection is thus not relevant to the present Action. For example, the Action refers to the preamble of claim 30 and to a medical log system, neither of which are relevant to rejected claim 15. Clarification or withdrawal of the rejection is respectfully requested.

Applicant further submits that, even if the rejection were properly applied, claim 15 is clearly distinguished from the claim in *Ex parte Lyell* cited by the Examiner. The *Lyell* claim clearly recited both a machine and a method in the preamble as well as in the body of the claim:

2. An automatic transmission tool in the form of ***a workstand and method*** for using same comprising:  
***a support means***, and [sic] internally splined sleeve affixed upright to said support means, a threaded adjustment bolt threadably engaged through a hole in the bottom of said support means and projecting upward through said support frame into said sleeve,  
***and further comprising the steps of***
  1. positioning the output end of an automatic transmission onto said upright sleeve,
  2. removing the internal components of said automatic transmission from the casing of said transmission,
  3. repairing and replacing said internal components back into said casing, and
  4. adjusting said internal components for fit and interference by means of adjusting said upwardly projecting adjustment bolt. (Emphasis added) *Ex parte Lyell* 17 USPQ2d, 1548, 1549 (BdPatApp&Int, 1990)

The rejection is upheld against *Lyell* because the claim clearly states that it includes a workstand and a method of using it within the same claim. In contrast, claim 15 is drawn to an electronic system for determining risk in a private investment portfolio. Claim 15 is written in

means plus function language and is clearly drawn to an electronic system rather than a method. For example, the claim clearly states "electronic means" for performing all of the steps a-g. Such a claim is proper since it is directed to a machine rather than a method. The structural means are defined in the Specification at page 7, paragraph [00020] and the machine produces a tangible result, number that represents the correlation of risk between a private investment and public investments such as stocks, for which risk is easier to determine based on index values.

Because claim 15 is clearly drawn to an electronic system for producing a tangible result the claim falls within the definition of 35 USC §101 and Applicants respectfully request that this rejection be withdrawn.

Rejections Under 35 USC §112

Claims 2-15 are rejected for lack of written description. Applicants respectfully traverse in that the Specification provides more than adequate written description of the claimed systems.

For example, the specification includes the description of a computer system that includes a CPU that is either a main frame connected to work stations or a stand alone or networked PC. The system also includes input devices, memory, software and a display device. The disclosure further includes a system for evaluation of private investments including a central processing unit or CPU (processor), which may be a main-frame computer connected to one or more work stations, or it may be a component of a personal computer that may be a "stand alone" computer or it may be networked to other computers through a common server. The system also includes an input device such as a keyboard in communication with the processor, at least one memory source and software including instructions. The device may also include a display device such as a monitor in communication with the processor. (page 7)

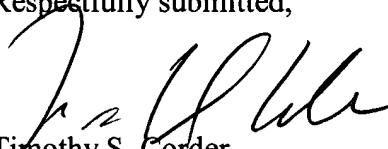
## PATENT

Based on the Specification as filed, therefore, one of skill in the art would understand that Applicants had full possession of the invention. Nothing more is required to satisfy the written description requirement of 112, 1<sup>st</sup>. Absent some evidence that one of skill in the art would not understand the claimed system and how to make and use such a system (and the Action has provided no such evidence) Applicants submit that the claims are fully supported by the Specification and request that this rejection be withdrawn.

### Conclusion

In light of the foregoing amendments and remarks, Applicants respectfully submit that all claims are in condition for allowance, and solicit an early indication to that effect. Should the Examiner have any questions regarding this response, she is invited to contact the undersigned representative at 512.542.8446.

Respectfully submitted,



Timothy S. Corder  
Registration. No. 38,414  
Agent for Applicant

VINSON & ELKINS L.L.P.  
First City Tower  
1001 Fannin Street  
Suite 2300  
Houston, Texas 77002-6760  
Ph: 512.542.8446

Date: September 16, 2005